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Amendments to the claims

Claims 1, 4, 6, 10, 13 and 16 have been amended, as indicated above. Support for the amendments is found in the specification at page 2, lines 17-18. No new matter has been added to the claims.

The amendments are being made herein are for the sole purpose of facilitating an understanding of the differences between the Applicant's claimed invention and the prior art, and are not to be considered as an admission that the prior art anticipated or rendered obvious the amended claims.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 1-4, 6-13, 15 and 16 have been rejected under 35 U.S.C. § 103 as being obvious admitted prior art (Applicant's background section) over Olson and Osogoshi (separately).

The Applicant respectfully disagrees that claims 1-4, 6-13, 15 and 16 are obvious as described above.

As a starting point, MPEP 706.02(j) states:

“[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. **Second**, there must be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) must teach or suggest **all the claim limitations.** **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.**” (Emphasis added.)

1 Independent claims 1 and 10 have been amended to clarify that the coating
2 applied to the sheet after printing the sheet is a transparent coating. As set forth in the
3 Applicant's specification (page 2, line 19 through page 3, line 3), the motivation for
4 developing the methods and apparatus of the present invention are to maintain the
5 integrity of print underlying the transparent protective coating against intrusive prior art
6 binding methods (such as stapling, stitching, etc.).

7 Accordingly, one seeking to solve the problem addressed by the Applicant's
8 claimed invention would not consider references that pertain to unprotected print, or non-
9 transparent coatings.

10 Neither Olson nor Osogoshi are in any way directed towards protecting print that
11 underlies a transparent protective coating against intrusive binding methods. More
12 generally, neither Olson nor Osogoshi are directed towards the use of transparent
13 protective coatings in any way, or towards protecting an image printed on a sheet.
14 Specifically, the coatings described in Olson are a "white opaque coating composition"
15 (Abst.), and "[t]hose thermoplastic coatings which remain opaque and do not form a
16 transparent or translucent film ... are acceptable from this standpoint for use in the
17 coating formulation" (Olson, Col. 3 lines 51-55, emphasis added.) Likewise, Osogoshi
18 specifies that the coating used "makes adhesives and a pigment a principle component"
19 (Osogoshi translation, ¶ 0010, emphasis added); that "the aforementioned coating
20 constituent five to 20% ... of a pigment" (Id.); and "[a]s a pigment of the coating
21 constituent used for this invention, well known pigments for coating, such as whiting, a
22 precipitated calcium carbonate, a kaolin, [etc.] can be mentioned, and it is chosen
23 suitably, and is combined and used." (Id. at ¶ 0012). That is, both Olson and Oshgoshi
24 are directed toward the use of non-transparent coatings.

25 Furthermore, the coatings used in both Olson and Oshogshi are intended to
receive ink, not protect ink. (See Olson, Col. 3, lines 70-71: "In order to give the coated
paper of this invention the desired properties of proper ink receptivity, ink holdout, ink

1 drying and setting characteristics, permanent opacity ..." (emphasis added). See also
2 Oshogshi translation, ¶ 0014, "... and the manufactured coated paper subsequently has
3 not [been] printed".)

4 Therefore, since neither Olson nor Osogoshi are directed towards (1) the use of
5 transparent coatings overlaying a printed image, and/or (2) the goal of protecting a
6 printed image, there is no "suggestion or motivation, either in the cited references
7 themselves or in the knowledge generally available to one of ordinary skill in the art, to
8 modify the reference[s] or to combine the reference teachings". (MPEP 706.02(j),
9 supra.) That is, one seeking to address the problem identified by the Applicant (of
10 protecting a printed image which is overlaid with a transparent coating, as
11 described above) would not look to references that teach applying a printed image over
12 an opaque coating.

13 The Applicant further maintains that Olson and Osogoshi are not relevant
14 references since they pertain to printing on a coating, versus using a coating to protect
15 an underlying printed image. That is, in seeking relevant references to address the
16 problem identified by the Applicant, one would look towards references pertaining to
17 protective coatings, not coatings configured to receive print in an unprotected manner.
18 For this additional reason the Applicant contends that the Examiner has not met the
19 requirements of MPEP 706.02(j) when citing Olson and Osogoshi.

20 The Applicant therefore requests that the references (Olson and Osogoshi) be
21 removed. Since the remaining reference (admitted prior art) does not contain all of the
22 elements of Applicant's claims 1 and 10, the claims should be allowed.

23 It is a well known axiom of patent law that if an independent claim is allowable,
24 then any claim depending therefrom is also allowable (and therefore nonobvious).
25 Claims 2-4 and 6-9 depend from claim 1, and claims 11-13, 15 and 16 depend from
claim 10. As set forth above, the Applicant contends that claims 1 and 10 are allowable.

1 Accordingly, claims 2-4, 6-9, 11-13, 15 and 16, are allowable for at least the same
2 reasons as set forth above with respect to claims 1 and 10.

3
4 Summary

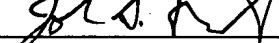
5 The Applicant believes that this response constitutes a full and complete
6 response to the Office action, and therefore requests timely allowance of claims 1-4, 6-
7 13, 15 and 16.

8 The Examiner is respectfully requested to contact the below-signed
9 representative if the Examiner believes this will facilitate prosecution toward
10 allowance of the claims.

11
12 Respectfully submitted,

13 Roland BOSS

14 Date: June 17, 2004

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